

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:	:		
Donna K. Lencki <i>et. al.</i> (Appellants)	:		
	:		
Conf. No.: 4094	:	Group Art Unit:	3626
	:		
Appln. No.: 09/748,359	:	Examiner:	Porter, Rachel L.
	:		
Filing Date: December 26, 2000	:	Attorney Docket No.:	051078-0020US
	:		
Title:	:		
SYSTEM AND METHOD FOR FACILITATING SELECTION OF BENEFITS	:		

REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

This Request for Rehearing is timely submitted in response to Decision on Appeal dated September 1, 2010.

Appellants respectfully submit that, in rendering its Decision on Appeal dated September 1, 2010, the Board misapprehended and/or overlooked the several points, described in the following.

In rendering its Decision, the Board considered representative claim 1, recited as follows in pertinent part:

1. A method of providing benefits to an employee comprising:
receiving an insurance coverage package selection from the employee, wherein the insurance coverage package corresponds to a benefit type and automatically includes coverage under a plurality of benefit categories associated with the benefit type;
for each of the plurality of benefit categories automatically included in the package, simultaneously displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network, wherein each of the different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category; and wherein the benefit cost presented to the employee for at least one of the different line items associated with the benefit category is non-zero;

. . . .

Claim 1 requires receiving an insurance coverage package selection from the employee, the insurance coverage package corresponding to a benefit type and automatically includes coverage under a *plurality of benefit categories* associated with the benefit type; and for *each of the plurality of benefit categories*, automatically included in the package, simultaneously displaying a *plurality of different line items* associated with the benefit category, wherein *each of the different line items* displayed on the interface includes an *out-of-pocket cost parameter* and a *corresponding benefit cost* to the employee.

In sustaining the Examiner's rejection of claims 1 – 4, 6 – 12, 15 – 17, 20 – 31, 34 – 36, 39 – 40, 42 – 48, 51, 70 – 73, 75 – 79, and 82 under 35 U.S.C. §103(a) in view of Wizig and Warady, the Board reasoned that Wizig disclosed each of elements listed above except that Wizig did not disclose displaying the out-of-pocket cost parameter and the corresponding benefit cost to the employee in a line item format. The Board reasoned that such line item formatting is disclosed in Warady, and it would be predictable to use such line item formatting in the system disclosed in Wizig “given that the information is already provided in a different format [in Wizig].” Appellants respectfully disagree.

Wizig does not disclose displaying a *plurality of different line items* associated with the benefit category, wherein *each of the different line items* displayed on the interface includes an *out-of-pocket cost parameter* and a *corresponding benefit cost* to the employee.¹ The Board asserts that Wizig discloses displaying a co-payment for each healthcare service provider (FF 04 in the Decision) and displaying the benefit cost for each provider as it is added to the panel (FF 05 in the Decision). However, Wizig does not disclose a *plurality of items* (in line item format or otherwise), for *each benefit category*, where *each item* includes an *out-of-pocket cost parameter* and a *corresponding benefit cost*. Assuming, without admitting, that each provider chosen for the panel inherently discloses a benefit category, as asserted by the Board, displayed along with each such alleged benefit category in Wizig is (1) a single out-of-pocket cost and (2) a benefit cost for the provider. *Plural* out-of-pocket costs and benefit costs are not displayed to the user

¹ Warady similarly does not disclose this element, a proposition with which the Board appears to agree.

for selection in Wizig, nor does the benefit cost displayed in Wizig *correspond to* the out-of-pocket cost. Instead, the benefit cost is *associated with the provider* chosen for the panel by the user. Thus, one skilled in the art *could not combine* the teaching of line item formatting in Warady with the teachings of Wizig to arrive at the claimed invention.

Section 2143.03 of the M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added). Because all of the claimed features are not taught or suggested in the cited art, a prima facie case of obviousness has not been established.

#

CONCLUSION

For these reasons, Appellants respectfully request that the Board reconsider its Decision on Appeal and reverse the rejections asserted in the last non-final Office Action of claims 1 – 4, 6 – 12, 15 – 17, 20 – 31, 34 – 36, 39 – 40, 42 – 48, 51, 70 – 73, 75 – 79, and 82 under 35 U.S.C. §103(a) in view of Wizig and Warady.

If there are any fees due in connection with the filing of this Request for Rehearing, please charge the fees to our Deposit Account No. 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: November 1, 2010

By: /Alison B. Weisberg/
Alison B. Weisberg
Reg. No. 45,206

Customer No.: 28977
MORGAN, LEWIS & BOCKIUS LLP
1701 Market Street
Philadelphia, PA 19103
Telephone: 215.963.5091
Facsimile: 215.963.5001